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10/084,857	02/25/2002	Jan Weber	S13.12-0128	6210
38356	7590	06/15/2006		EXAMINER
BROOKS & CAMERON, PLLC 1221 NICOLLET MALL #500 MINNEAPOLIS, MN 55403				BUI, VY Q
			ART UNIT	PAPER NUMBER
			3734	

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/084,857

**MAILED**

Filing Date: 2/25/2002

**JUN 15 2006**

Appellant(s): WEBER, JAN

**Group 3700**

Joseph C. Huebsch  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 3/24/2006 appealing from the Office action mailed 11/23/2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

**NEW GROUND(S) OF REJECTION**

In response to the Applicant's arguments raised the first time in the Appeal Brief (3/24/2006), new references are relied upon for 103(a) rejections of claims 12, 28 as presented below.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,364,823	Garibaldi et al.	4-2002
6,786,904	Doesch et al	9-2004

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-2, 4-7, 20-25, 43 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Garibaldi et al.-6,364,823.

As to claims 1-2, 4-7 and 20-25, Garibaldi et al.-6,364,823 (col. 7, line 64 to col. 8, line 61; Fig. 10-13) discloses a medical device 120 (can be used as an embolic coil or a stent) having magnetically susceptible material/particles disposed around a core of nitinol 122, an magnetic field B. The magnetically susceptible material (particles) has a Curie point below normal body temperature of 98.6 F (col. 13, lines 9-33) so that when deployed in a patient, the patient body will cause the magnetically susceptible material (particles) to decrease the magnetic susceptibility.

As to claims 43 and 47, Garibaldi et al.-6,364,823 discloses patch 120 including nitinol hoop/core 122 (col. 8, lines 2-6).

2. Claim Rejections - 35 USC 103 (a):

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 11-12, 26, 28-29, are rejected under 35 U.S.C. 103(a) as being unpatentable over Garibaldi et al. 6,364,823.

As to claims 8, 11, 26 and 29, Garibaldi et al. 6,364,823 discloses substantially the invention and core 122 made of a nitinol so that the medical device can open when released from a catheter. Garibaldi-'823 does not explicitly disclose the core 122 made of a magnetically susceptible material. However, Garibaldi-'823 discloses a metal gadolinium (col. 13, lines 9-33) as a magnetically susceptible material. Gadolinium has a high modulus of elasticity (about 76 Gpa) comparable to a nitinol (about 40-75 Gpa). It would be obvious to one of ordinary skill in the art at the time to the invention to substitute nitinol core 122 of the Garibaldi-'823 device by gadolinium core 122 so that the medical device can elastically expand when it is released from a compressed configuration.

As to claim 12, Garibaldi et al. 6,364,823 discloses substantially the invention and the magnetically susceptible material being gadolinium or PdNi. Garibaldi et al. 6,364,823 does not disclose FeO (Ferrite Oxide) or CrO (Cromium Oxide) a magnetically susceptible material. However, FeO (Ferrite Oxide) or CrO (Cromium Oxide) are well known magnetically susceptible

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material. It would have been obvious to one of ordinary skill in the art at the time of the invention to use FeO or CrO (Chromium Oxide) as a magnetically susceptible material in place of a gadolinium or a PdNi as CrO is a well known magnetic material.

As to claim 28, Garibaldi et al. 6,364,823 does not disclose less than the total core is coated with magnetically susceptible material. Doscher '904 (col. 10, lines 46-67; claim 21) discloses selective coating of the stent to direct heat generation to a selective portion of the stent. It would have been obvious to one of ordinary skill in the art at the time of the invention to coat the core less than the total core for this configuration would direct the heat generation to a selective portion of the stent as one desires.

As to claims 42, 44-46, 48-49, Garibaldi et al. 6,364,823 discloses substantially the invention. The claims refer to methods of coating, the methods of coating will be given patentability in method claims.

#### **(10) Response to Argument**

Applicant's arguments filed 3/24/2006 (Appeal Brief) have been fully considered but they are not persuasive.

As to the arguments regarding the 102(e) rejection of independent claim 1: Girabaldi- '823 (Figs. 10-13; col. 7, line 64 to line 61, col. 8) explicitly discloses using magnetic patches 120 as an embolic material or a stent to support a blood vessel in an intravascular treatment such as an angioplasty procedure, which patches 120 have a magnetic susceptibility that decreases within a preselected temperature range and a magnetic material whose Curie point below normal body temperature can be used to make patches 120 to form a stent. Girabaldi- '823 (abstract; col. 13, lines 10-33) suggests that one can use a magnetic material (such as

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Gadolinium having Curie temperature of 15 Celsius degrees, or PdNi having Curie temperature of 32 Celsius degrees) with a Curie temperature below body temperature to form an embolic material or a stent. Notice that body temperature of 98.6F or 36 Celsius is greater than the Curie temperature of the magnetic material and therefore the body temperature would decrease magnetic property of the stent formed with patches 120 made of magnetic material according to the teaching of Girabaldi-'823. Further, a Curie temperature is an inherent physical characteristics of a magnetic material. Therefore, when a magnetic material of stent 120 is preselected (for example, Gadolinium having Curie temperature of 15° C or PdNi having Curie temperature of 32° C), the associated Curie temperature of the magnetic material is also preselected. In addition, the claim only recites a preselected temperature range and not a specific range to make the claimed invention different from the Girabaldi-'823 reference.

As to the arguments regarding the 102(e) rejection of independent claim 20: Girabaldi-'823 (Fig. 4B, 6B, 22-23) discloses electromagnetic field B. As admitted in the specification of the present invention (line 15, page 1 to line 2, page 2), a change in the magnetizing force will result in some heat in the stent. Inherently, a change in an electromagnetic field from a zero value to B value applied to Girabaldi-'823's stent 120 will create some level of heat in stent 120. Therefore, Girabaldi-'823 inherently discloses the claimed invention.

As to the arguments regarding the 103(a) rejection of claims 8, 11, 26 and 29: it is noticed that the arguments in the Appeal Brief (3/24/2006) are presented the first time for the same rejection in the first non-final office action (paper 5/16/2005) and final office action (paper 11/23/2005). The Applicant argues that Gadolinium is a malleable and ductile material and can not function in the same way as nitinol. In response, as mentioned in the final office action, the

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Examiner would like to assert that because Gadolinium is elastically comparable to Nitinol (please, see the rejection of the claims above), the stent formed of Gadolinium should expand/open to the original shape/configuration after being releasing from a compressed configuration.

As to the arguments regarding the 103(a) rejection of claim 12: it is noticed that the arguments in the Appeal Brief (3/24/2006) are presented the first time for the same rejection in the first non-final office action (paper 5/16/2005) and final office action (paper 11/23/2005). In response, please notice that a substitute of a magnetic material such as Gadolinium for another well known magnetic material such as FeO or CrO is considered within level of one of ordinary skill in the art.

As to the arguments regarding the 103(a) rejection of claim 28: it is noticed that these arguments in the Appeal Brief (3/24/2006) are presented the first time for the same rejection in the first non-final office action (paper 5/16/2005) and final office action (paper 11/23/2005). Because the new arguments, the Examiner has to refer to a new reference (MPEP 1207.03), Doscher et al-6,786,904, to support the rejection. Please, see the rejection above.

As to the arguments regarding the 103(a) rejection of claims 44, 45, 48 and 49: the claims recite methods of making the coating. These methods of coating will be given patentability in method claims.

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As to the arguments regarding the 103(a) rejection of claims 42 and 46: claims 1 and 20 have been rejected as presented above. Claims 42 and 46 dependent to claims 1 and 20 do not include an allowable subject matter are also rejected.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid **sua sponte dismissal of the appeal** as to the claims subject to the new ground of rejection:

**(1) Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

**(2) Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

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Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,



Vy Bui

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

Conferees/ Designees

  
Michael Hayes  
Eduardo Robert